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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,189

03/18/2004

Mike Fard

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WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

SAN MIGUEL, ANITZA M

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

06/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,189

Applicant(s)

FARD, MIKE

Examiner

Anitza M. San Miguel

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 67, 68 and 70-77 is/are pending in the application.
- 4a) Of the above claim(s) 14-66, 69 and 78-121 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 67, 68 and 70-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/18/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I (Claims 1-13 and 67-77) and Species 2 (Figures 5a-5b) in the reply filed on May 3, 2007 is acknowledged. The traversal is on the ground(s) that the search of the Group 2 Invention (Claims 14-60) would not place an undue burden on the Examiner. This is not found persuasive because searching for the Invention of Group 2 requires a different search.

The applicant has elected Species 2 (Figures 5a-5b) with traverse. The traversal is on the ground(s) that the non-elected species meet the requirements of every other claim in the elected invention. This is not found persuasive because it is clear from the Figures that the embodiments are different species.

It is acknowledged that applicants believe that the elected claims of Group I (Claims 1-13 and 67-77) read on the elected species. It is noted that comparison of the claims with Figures 5a-5b and the specification shows, however, that the species of Figures 5a-5b does not have "a hook" as required in claim 69.

Claims 14-66, 69, 78-121 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 3, 2007.

The requirement is still deemed proper and is therefore made FINAL.

Oath/Declaration

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

The Oath/Declaration does not have the correct statement with regard to the duty to disclose. The corrected statement should read, "I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

Drawings

Figure 1A and 1B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "218" in Figure 3, "331" in Figure 5A, and "403" in Figure 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification

to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "370" (page 10) and "25 (page 12). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

In page 4, line 11, there appears to be a typographical error; "atht eh" should be changed to - - at the - -.

In page 5, line 12, there appears to be a typographical error; "bo" should be changed to - - be - -.

In page 7, lines 19-22, reference "205" refers both to "the attachment tabs" and "the holes". However, reference "206" previously disclosed "the holes".

In page 9, lines 5, reference "213" refers to "the guide track or groove", however, reference "213" previously disclosed "the flange" (page 8, lines 6). Also, "the guide track" was previously disclosed with reference "204" (page 7, lines 16-17).

In page 10, line 21, reference "330" refers both to "the pre-bent tab" and "the template". However, reference "300" previously disclosed "the template" (page 10, line 2).

In page 15, line 3 and 6, reference "503" refers both to "the cutting means" and "the support means". However, reference "502" previously disclosed "the cutting means" (page 14, line 31).

In page 16 and 17, line 5 and 4, respectively, reference "608" refers both to "the bottom surface" and top surface" (line1-2). However, reference "609" previously disclosed "the bottom surface" (page 16, line 2).

In page 16, lines 27-29, reference "607" discloses both "the tips" and "the extremities".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, 67, 68, and 70-77 are rejected under 35 U.S.C. 102(b) as being anticipate by Dietz et al. (Reference U.S. Patent "5,486,180").

Dietz et al. (herein Dietz) discloses a template (1) comprising: a frame (7) having a top, a bottom, one or more external sidewalls, and one or more internal sidewalls (see Figure 1 below), said frame (7) having one or more openings extending there through from said top to said bottom wherein at least one of said one or more internal side walls defines a peripheral boundary of each of said one or more openings (see Figure 1 below; col. 2, lines 38-39); a guide track (15,18; see Figure 1 and 6 below) formed in said one or more internal sidewalls, said guide track (15,18) receiving a guide of a bone milling device (col. 2, lines 16-21) whereby said bone milling device may be moved about said peripheral boundary using said guide track (15,18; col. 2, lines 16-12 and 58-67; col. 3, lines 1-19). It is noted that Dietz explicitly discloses another embodiment where the template contains a track for guiding the bone milling device (see Figure 6

and 7 below). The template (1) further comprises a pre-bent fastening means means for removably securing said frame (7) to a posterior surface of a bone, which is to be milled (col. 2, lines 28-30).

The means for removably securing includes one or more tabs (pre-bent) projecting from said frame (7) which have one or more securing points which may be secured to a bone (col. 2, lines 28-36). One or more tabs project from said one or more external side walls (see Figure 1 below).

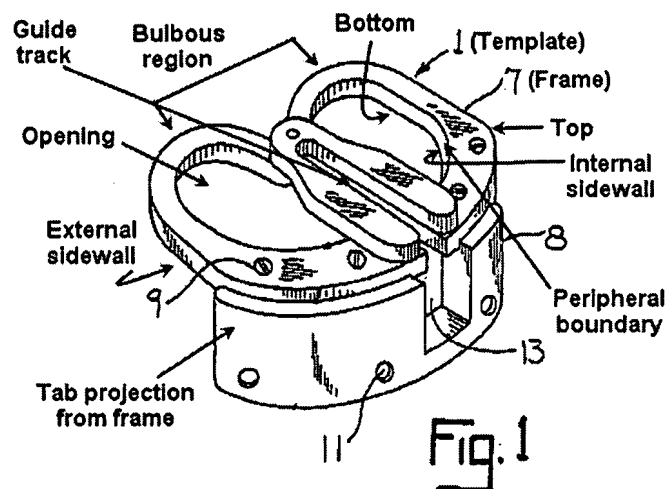
The guide track (15,18; see Figure 1 and 6 below) is positioned approximately midway between said top and said bottom of said frame (7). The guide track (15,18) has a flat lower surface, which is approximately parallel to said top and said bottom of said frame (col. 2, lines 39-61). The guide track (15,18) has an angled upper surface which projects at an angle from said lower surface to a point relatively closer to said top of said frame than said bottom of said frame (col. 2, lines 39-67 and col. 3, lines 1-19). The guide track (15,18) has an arcuate upper surface, which extends from said lower surface to a point relatively closer to said top of said frame than said bottom of said frame (col. 2, lines 65-67 and col. 3, lines 1-19). The guide track (15,18) has an arcuate lower surface and an angled upper surface which projects at an angle from said lower surface to a point relatively closer to said top of said frame than said bottom of said frame (col. 2, lines 65-67 and col. 3, lines 1-19).

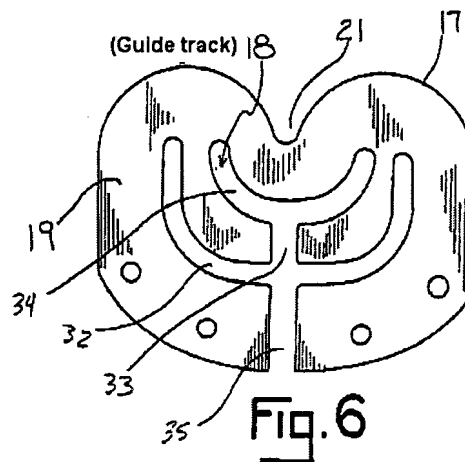
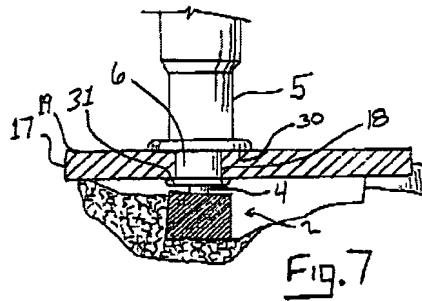
The frame (7) is curved to match one or more curves of a bone. The frame (7) has a peripheral boundary in shape configured to accommodate a femoral or tibial implant (col. 3, lines 36-41). It is noted that the peripheral boundary disclosed by Dietz

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is capable of being used as claimed if one so desires to do so. The peripheral boundary has one or more bulbous regions (see Figure 1 below).

With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Dietz (i.e. "configured to accommodate a femoral implant"), which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).





Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited art of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anitza M. San Miguel whose telephone number is 571-272-3279. The examiner can normally be reached on 8:00 am - 5:30 pm EST (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASM



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER